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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/712,355

11/13/2003

An H. Lam

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07/17/2006

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EXAMINER

BAE, JI H

ART UNIT

PAPER NUMBER

2115

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/712,355

Applicant(s)

LAM, AN H.

Examiner

Ji H. Bae

Art Unit

2115

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-14 is/are allowed.
- 6) ☐ Claim(s) 1,5,7-9 and 15-20 is/are rejected.
- 7) ☒ Claim(s) 2-4 and 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments, see applicant's remarks, page 7, filed on 2 May 2006, with respect to rejection of claims 2-4 under 35 U.S.C. 112 have been fully considered and are persuasive. The rejection of claims 2-4 has been withdrawn.

Applicant's arguments with respect to prior art have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 17, applicant has recited that the system comprises means for "permitting" BIOS code stored on the system ROM to be executed by the processor. Usage of "permitting" does not properly define the scope of applicant's claim, as "permitting" may be interpreted to include any means that does not expressly prohibit the action from taking place. For example, a computer system may "permit" a given action may occur, so long as there is absence of any teaching that would explicitly prevent that action from taking place.

Claims 18-20 are rejected on similar grounds.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, 7-9, and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al., U.S. Patent No. 5,805,882, in view of Kedem et al., U.S. Patent No. 6,477,624 B1.

Cooper teaches a processor adapted to read BIOS code from a system ROM [col. 3, lines 5-17], but does not teach a management controller or network interface controller for trapping read accesses to the system ROM.

Kedem teaches a system wherein a management controller traps read accesses to a local storage area, and causes a network interface controller to download data from storage external to the system [col. 3, lines 62-67, col. 3, lines 4-9, 30-38].

It would have been obvious to one of ordinary skill in the art to combine the teachings of Cooper and Kedem by modifying Cooper to include a management controller and network interface controller, with functionality as suggested by Kedem. Cooper's system is concerned with providing capability for updating BIOS code for a system ROM when the BIOS code is either obsolete or corrupted. However, Cooper's implementation is not transparent to the system or the user, as it requires an external data port through which the updated BIOS is to be loaded into the system [col. 3, lines 18-26]. By applying the teachings of Kedem regarding a management controller that traps read accesses to local storage and redirects to a network for downloading a most current data image, the system of Cooper would be improved by providing a transparent method of keeping the BIOS up-to-date. More specifically, a BIOS may be kept

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up-to-date via a central storage area [col. 5, lines 1-11], and the updates could be performed transparently without user or operating system action [col. 5, lines 32-36].

Regarding claims 5, 15, and 18, Cooper/Kedem teaches the system of claim 1, and also the controller and method implemented by the system.

Regarding claim 7, Cooper teaches that the downloading the entire externally stored BIOS software.

Regarding claim 8, Kedem teaches downloading a portion of the remotely stored data image [col. 4, lines 4-23].

Regarding claim 9, Kedem teaches downloading additional portions for each read request trapped.

Regarding claim 16, Kedem teaches means for disabling the local storage, and transmitting all read/write requests to the remote data storage by default [col. 4, lines 52-60].

Regarding claim 17, Cooper teaches means for permitting BIOS code stored on the system ROM to be executed by the processor.

#### ***Allowable Subject Matter***

Claims 10-14 are allowed.

Claims 2 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

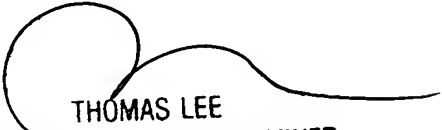
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ji H. Bae whose telephone number is 571-272-7181. The examiner can normally be reached on Monday-Friday, 10 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Lee can be reached on 571-272-3667. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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